

U.S. Patent Application Serial No. 09/712,927
Amendment filed September 24, 2004
Reply to OA dated July 13, 2004

REMARKS

Claims 1-3, 5, 6, 8-11, 13, 14 and 16 are pending in this application. An amendment is proposed canceling claims 3 and 11 without prejudice or disclaimer, and amending claims 1, 6, 9 and 14. Upon entry of this amendment, claims 1, 2, 5, 6, 8-10, 13, 14 and 16 will be pending. An amendment to the specification is also proposed.

The amendment to claims 1 and 9 inserts the limitation of “a diameter within the range of 0.3 to 1.6 μm ” for the fine particles having a positive charge polarity. Support for this amendment is discussed below. The amendments to claims 6 and 14 are for proper dependency in view of the cancellation of claims 3 and 11.

The amendment to the specification is discussed below.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

The objection is overcome by the proposed amendment to the specification.

The Examiner states that the electrostatic charge of AEROSIL R812, NY-50 and RX-50 must be added to the specification to provide proper antecedent basis for the claim limitations of the hydrophobic silica having a negative charge.

In the proposed specification amendment, Applicant has amended the specification where reference is made to R812, NY-50, RX-50, and RY-50, to indicate that these are silicas “having a negative charge polarity.” Applicant submits that no new matter is added by this amendment, since this is a known property of these materials. In the previous Amendment, Applicant indicated that the

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recitation of negative charge polarity was supported by the use of “R812,” “R972D,” “NY-50” and “RX-50” in the examples in the specification. The Technical Information Sheet provided with the previous Amendment supports this.

Reconsideration of the objection is therefore respectfully requested.

Claims 1-3, 5, 6, 8-11, 13, 14 and 16 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Reconsideration of the rejection is respectfully requested in view of the proposed amendments to the claims.

In the rejection, the Examiner notes that the recitations of the “hydrophobic silica having a negative charge polarity” and the particles “having a positive charge polarity” are supported by the specification (see Office action, page 3, lines 16-19).

However, the Examiner states that: “the specification does not, however, provide a description of any size fine particles having a positive charge polarity as another component of the external additives.” In particular, the Examiner states that the specification states that the external particles comprise at least particles having a mean diameter of 30 to 100 nm and particles having smaller particle diameters than the particles having a particle diameter of 30 to 100 nm. The Examiner refers in particular to page 7, lines 18-21. The Examiner states that “the claims continue to permit the fine particles to have any size, which is without basis in the specification as filed.”

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The proposed amendment to claims 1 and 9 inserts the limitation of “a diameter within the range of 0.3 to 1.5 μm ” for the fine particles having a positive charge polarity. This overcomes the rejection by limiting the size of the fine particles having a positive charge polarity to a range supported by the specification.

Support for this amendment may be found in claims 3 and 11, which are accordingly canceled without prejudice or disclaimer. Claims 1 and 9, as amended, therefore have the scope of claims 3 and 11 before cancellation.

Applicant also indicates support for the amendment in the specification, as follows. The original wording of the “fine particles having a positive charge polarity” in the claims was “fine particles having an opposite charge polarity,” this being amended in the Amendment dated June 8, 2004. These particles are referred to on page 30, lines 16-20, where it states:

“As will be understood from the Table 1, the fine particles having an opposite charge, that is, the fine particles having an opposite polarity, preferably have a particle diameter within the range of 0.3 to 1.5 μm .”

Applicant submits that the specification therefore supports the amendment reciting that the “fine particles having an opposite charge polarity” particles, now limited to “positive charge polarity,” have a diameter within the range of 0.3 to 1.5 μm .

Again, reconsideration of the rejection is respectfully requested.

In view of the aforementioned amendments and accompanying remarks, the claims, as amended, are in condition for allowance, which action, at an early date, is requested.


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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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